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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,574	04/15/2004	Kurt Brooks Uhler	N0189US	8870
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EXAMINER				
HU, KANG				
ART UNIT		PAPER NUMBER		
3715				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/825,574

Applicant(s)

UHLIR ET AL.

Examiner

KANG HU

Art Unit

3715

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8, 11-14, 17-19, 23 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8, 11-14, 17-19, 23 and 36-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Present office action is in response to amendment filed on 10/27/2009. Claims 1, 9, 10, 15, 16, 20-22, and 24-35 were previously cancelled. Claim 39 has been added. Currently claims 2-8, 11-14, 17-19, 23, and 36-39 are pending in the application.

Election/Restrictions

1. Newly submitted claim 39 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 2-8, 11-14, 17-19, 23, and 36-38, drawn to method, system, and computer readable medium having executable instructions for comparing two different geographic areas, and comparing the performance of users on said different geographic areas.

II. Claim 39, drawn to method of using geographic data retrieved from a database to provide simulated data to a stationary device, and comparing the performance of users on the course with another user on the stationary simulated environment.

Inventions I and II are directed to related processes. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are

mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed do not overlap in scope, and are not obvious variants. Invention I is directed to identify and present a course in a second geographic area that is different from the first geographic area to the user based on attributes of the course at the first geographic area, comparing the performance of the first user on a first course to a second user on a second course, providing result to the users. Invention II is directed to method of providing a user with a simulated environment of a course according to the geographic data retrieved from a first course. The inventions are distinct from each other as they do not overlap in scope, each of the inventions provide a different aspect used alone for different intended purposes. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

2. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 39 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 2-8, 11-14, 17-19, and 36 are rejected under USC 101, the claimed invention is directed to non-statutory subject matter. In order for a claimed process to be considered statutory it must be: (1) tied to a particular machine or apparatus, or (2) transform a particular article into a different state or thing. The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility; the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity; and the transformation must be central to the purpose of the claimed process. Claim 36

as recited do not act upon a physical object so as to provide a transformation of that object into a different state or thing. Further the claims do not recite a tie to a particular machine or apparatus. Although claim 36 recites the features of using a geographic database and identifying data in the geographic database, the geographic database stored on data storage. The recited geographic database is merely nominal recitation and do not make any explicit recitation of a particular machine which is critically tied to the performance of the method. The recitation of geographic database stored on data storage merely provides the intended use of the data structure stored on data storage and also does not make any explicit recitation of a particular machine which is critically tied to the performance of the method. The applicant is suggested to provide positive recitation of a particular machine which is critically tied to the performance of the method as supported by the specification, exemplary claim language such as identifying by the computer processor ... data in the geographic database, and determining by the computer processor a second course located...

Claims 2-8, 11-14, 17-19 are rejected for its dependency upon claim 36 for failing to correct these deficiencies. As such, they are rejected for the same reason.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-8, 11-14, 17-19, 23 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muendel (WO 01/42809 A2) in view of Nimura et al. (US 6,098,015)

Re claims 36-38, Muendel teaches a method for facilitating a first performance by a participant in an event that includes movement along a first course located in a first geographic area, the method comprising:

using a geographic database that contains data that represents geographic features to compare the geographic features of the first course to the geographic features in a second geographic area different from the first geographic area, the geographic database stored on data storage hardware (Muendel, page 18, line 18- page 19, line 2: using a digital elevation model database to engineer a local training route that has a similar elevation profile to that of the race, and the GPS device can guide them along the route. The DEM might be overlaid with a roadmap or map of other features of interest to aid in route planning);

identifying, based on the comparison, data in the geographic database representing geographic features in the second geographic area that substantially match the geographic features of the first course (Id. elevation profile);

Muendel teaches of determining a second course located in the second geographic area based on the identified data, however Muendel does not explicitly teach of identifying the second geographic area based on attributes of a substantially equivalent surface, a substantially equivalent length, substantially equivalent turns, connectivity of roads, address ranges, street names, and geographic coordinates as the first course; Nimura teaches of attributes of surface, length, turns, connectivity of roads, address ranges, street names and geographic coordinates as

the first course (Nimura, col 7, line 45 - col 8, line 28: width of surface, length, turns; col 3, lines 25-50: road attribute data, address and size of shape; col 4, lines 49-52: point coordinates, road name); It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Nimura to Muendel to include the attributes specified in Nimura in determining a second equivalent course to the first to provide a best suitable course to the user as desired.

Muendel further teaches of comparing the first performance to a second performance, wherein the second performance is along the second course (Muendel, page 27, line 23- page 28, line 20); and providing an indication of the comparing of the first and second performances to the participant (Muendel, page 28, line 20: winner's flag).

Muendel further teaches:

Re claim 2, the event is one selected from a group consisting of: running, cross-country skiing (Muendel, page 1, lines 16-18).

Re claim 3, selecting the second course to be equivalent to the first course by applying a factor selected from a group consisting of elevation changes (Muendel, page 18, lines 23-25).

Re claim 4, selecting the second course to be equivalent to the first course by applying a personal factor selected from a group consisting of age (Muendel, page 28, line 17).

Re claims 5 and 6, determining positions of the first participant during the first performance (claim 5) and the positions of the first participant are determined using a first positioning device (claim 6) (Muendel, page 24, lines 13-25).

Re claims 7 and 13, the first/second positioning device is selected from a group consisting of: a global positioning system unit (Muendel, page 24, line 18).

Re claims 8 and 14, the positions of the first/second participant are transmitted as data wirelessly from a first/second communications device located with the first/second participant (Muendel, page 21, line 11: IR type interface).

Re claims 11 and 12, determining positions of a second participant during the second performance (claim 11) and wherein the positions of the second participant are determined using a second positioning device (claim 12) (Muendel, page 28, lines 4-15).

Re claim 17, the second performance is by the first participant, but occurred at a time previous to a time of the first performance (Muendel, page 10, line 5: other courses).

Re claim 18, the indication is provided to the first participant during the event (Muendel, page 14, line 20 – page 15, line 7).

Re claim 19, Muendel teaches of providing the indication of the comparing of the first and the second performances to the second participant during the second performance (Muendel, page 30, lines 9-16: providing real time athletic performance data). Muendel does not explicitly teach of requiring the first and second performance to start at the same time. Muendel teaches of creating a virtual competition where the races can be spatially and or temporally juxtaposed. Nimura teaches of attribute of time of travel (Nimura, col 8, lines 21-25). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Nimura to Muendel to also include time of travel as an attribute in the comparison of the performance of the athletes in order to provide the best equivalent performance comparison.

Re claim 23, the participant's performance is monitored by a positioning unit that determines positions of the participant in the first geographic area while the participant is moving along the first course in the first geographic area (Muendel, page 10, lines 9-25).

Response to Arguments

6. Applicant's argument with respect to claims 2-8, 11-14, 17-19 and 36 under 35 U.S.C. 101 have been carefully considered and addressed in the rejection above and not repeated herein. Applicant's amendment to claims 36-38 has overcome the 112 2nd rejection and have been withdrawn. Applicant's arguments with respect to claims 2-8, 11-14, 17-19, 23 and 36-38 in regards to the 102 rejection have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KANG HU whose telephone number is (571)270-1344. The examiner can normally be reached on 8-5 (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-262-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/
Primary Examiner, Art Unit 3715

/K. H./
Examiner, Art Unit 3715